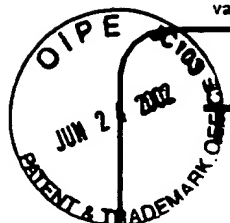


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(Modified) PTO/SB/21 (6-98)  
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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/394,019
Filing Date	September 10, 1999
First Named Inventor	Akira Komoriya
Group Art Unit	1653
Examiner Name	Robinson, P.
Attorney Docket Number	300-903830US

Total Number of Pages in This Submission

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): receipt acknowledgment postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	<b>Authorization to Charge Deposit Account</b> Please charge Deposit Account No. 50-0893 for any additional fees associated with this paper or during the pendency of this application, including any extensions of time for consideration of the documents enclosed.	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	Remarks	

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Tom Hunter, Reg. No. 38,498, Quine Intellectual Property Law Group P.C.
Signature	
Date	June 17, 2002

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: June 17, 2002

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By:

Chih Min Kam



Atty Docket No: 300-903820US

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re application of:

**AKIRA KOMORIYA and BEVERLY  
PACKARD**

Application No.: **09/394,019**

Filed: **09/10/1999**

For: **COMPOSITIONS FOR THE  
DETECTION OF ENZYME ACTIVITY IN  
BIOLOGICAL SAMPLES AND METHODS  
OF USE THEREOF**

Examiner: Chih Min Kam

Art Unit: 1653

**RESPONSE TO COMMUNICATION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This document is filed in response to the Communication (paper 24) mailed on May 15, 2002. IN that communication, the Examiner alleged that the replay filed on April 30, 2002 is not fully responsive to the prior Office Action mailed November 21, 2001 (Paper No: 21) because Applicants did not elect one amino acid sequence, one fluorophore, and one hydrophobic group for the elected invention, Group I, claims 1-15.

Applicants note that the Examiner's election of species fails to comply with the requirements of such an election as set forth in MPEP §809.02(a) which states:

Action as follows should be taken:

- (A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.
- (B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. **The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively.** In the absence of

distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. [emphasis added]

In the instant case, the Examiner has failed to indicate which claim(s) are generic or to indicate that no generic claims are present. In addition, the Examiner has failed to specifically identify each of the species. Moreover, the particular material, or other distinguishing characteristic of the species has not been stated for each species identified. Indeed, from the Office Action, Applicants cannot ascertain what constitutes a species in the Examiner's opinion, or even how many species are present.

For example, it is unclear whether the Examiner requires an election of a sequence from claim 1, pertaining to particular "P" domains or an election of a sequence from claim 4.

Nevertheless in the interest of compact prosecution, in response to this restriction requirement, Applicants elect s a species within Group I comprising:

- 1) The amino acid sequence: KDPJGLEHDDING, JPKGY (SEQ ID NO:248);
- 2) The fluorophore 9-(2,5 (or 2,6)-dicarboxyphenyl)-3,6-bisamino-xanthylium halide or other anion (Rh110) (item 5 in the Markush Group of claim 9); and
- 3) The hydrophobic group: 9-fluoreneacetyl group (item 2 in the Markush Group of claim 12).

With respect to the listing of claims readable on the elected species, Applicants note that claim 1 is generic and claim 1 and dependent claims 2-12 and 15 are readable on the elected species.

Applicants understand that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141.

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If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



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